

R E M A R K S

Claims 1-22 are currently pending in the present application. In the instant Office Action, the Examiner raised a number of issues which are set forth by number in the order they are herein addressed:

- 1) Abstract is objected to per MPEP § 608.01(b);
- 2) Claims 1-22 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement;
- 3) Claims 1-22 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite and incomplete; and
- 4) Claims 1-22 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Buzga *et al.* (US 4,073,661) in combination with Anderson *et al.* (US Patent No. 5,185,041) and Kiuchi *et al.* (US Patent No. 5,083,447).

Applicants hereby amend Claims 1 and 14, and cancel Claim 15, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments. Applicants reserve the right to prosecute the original, similar, or broader claims in one or more future application(s). These amendments do not introduce new matter and are not intended to narrow the scope of any of the claims within the meaning of *Festo*.¹

1) Abstract Is Proper

The Examiner has objected to the abstract because of the word "comprising" at line 1 per MPEP § 608.01(b) (Office Action, page 2). In order to advance their business interests and without acquiescing to the Examiner's argument, while expressly reserving the right to prosecute the patent as originally filed, Applicants have replaced "comprising" with "The plant having ... " to obviate this objection.

¹ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002).

2) The Claims Meet the Written Description Requirement

The Examiner has rejected Claims 1-22 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner states that the "specification, as originally filed, provide support for 'plastic material in a quantity of scales', and provide support for 'washing recyclable plastic material', and, 'preferably reduced to scales' (see page 2, lines 10-13)" (Office Action, pages 2 and 3). Applicants must respectfully disagree that the claims fail to meet the written description requirement. Nonetheless, Applicants have amended Claims 1 and 14, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments, and while reserving the right to prosecute the original, similar, or broader claims in one or more future application(s). In particular, Applicants have amended Claims 1 and 14 to recite "scales of plastic material." Support for this amendment is found in the Application as filed, which teaches for instance:

a plant for the continuous washing of plastic material in scales and, in particular, of scales made of recyclable PET. The plant in particular comprises a washing apparatus 1 equipped with an stirrer 2 set in rotation by an electric motor 3, with a plurality of vanes 4 that impart an action of agitation to both a washing fluid, consisting preferably of an aqueous solution, and the *scales of plastic material* present in the apparatus 1 (Specification, at page 6, lines 1-8, emphasis added).

As the amended claims meet the written description requirement, Applicants respectfully request that this rejection be withdrawn.

3) The Claims Are Definite

The Examiner has rejected Claims 1-22 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. In the first place, the Examiner states that "Claims 1 and 14 are indefinite, because it is not clear if the plastic material and the scales are different. It is not clear if the plant is for washing a plastic material or scales, because the claims do not include components for washing plastic material" (Office Action, page 3). Applicants respectfully disagree that the claims are indefinite. Nonetheless, Applicants have amended Claims 1 and 14, as discussed above, to recite "scales of plastic material." Moreover, for the sake of clarity, Applicants have amended Claim 1 to recite devices for feeding and withdrawing scales of plastic material "in a continuous way to said washing apparatus." Support for this

amendment is found for instance, in original Claim 14. Thus, the amended claims clearly indicate that the claimed plant and method is for washing plastic material in the form of scales (plastic material and scales are *not* different).

In the second place, the Examiner rejects Claims 14-22 "as being incomplete for omitting essential steps ... [t]he omitted steps are: the steps of washing the plastic material" (Office Action, page 3). Applicants must respectfully disagree. Nonetheless, Applicants have amended Claim 14 and canceled Claim 15, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments, and while reserving the right to prosecute the original, similar, or broader claims in one or more future application(s). In particular, Applicants have amended Claim 14 to recite "washing said scales of plastic material over a varying time by acting on the quantity of scales fed to said washing apparatus and on the quantity of scales withdrawn from said washing apparatus." Support for this amendment is found for instance, in canceled Claim 15, as well as the preamble of original Claim 14, in combination with the section of the Specification cited above. Thus, the amended method claims comprising an explicit washing step are clearly complete. As the amended claims are definite, Applicants respectfully request that this rejection be withdrawn.

4) The Claims Are Nonobvious

The Examiner has rejected Claims 1-22 under U.S.C. §103(a), as allegedly being unpatentable over Buzga *et al.* ('661) in combination with Anderson *et al.* ('041) and Kiuchi *et al.* ('447). The Examiner states:

"Buzga *et al.* as discussed supra in paper No. 4 teach all the limitation with the exception of 'means and step of continuously varying the time the scales remain in the washing apparatus as a function of the quantity of scales contained at the same moment in said apparatus, and the filter as claimed.

Anderson *et al.* teach a process and apparatus for washing plastic fragments, in a continuous fashion as part of recycling operation. Anderson *et al.* teach the filter means as claimed. See the abstract, cols. 1, 2, col. 7, lines 17-38, and the claims.

Kiuchi *et al.* teach a washing machine which is arranged to control washing and rinsing operations. A control unit for controlling washing and rinsing operations. The control unit controls the washing and rinsing operation based on the data of the laundry volume detected by the volume sensor. The

reference also teaches that the washing time is varying as a function of varying the volume of the laundries. See col. 9, lines 26-40, and col. 12, lines 44-68.

It would have been obvious for one skill in the art to use the filter means taught by Anderson et al. and the means for varying the time taught by Kiuchi et al. in the Buzga et al. [apparatus] to obtain the claimed invention. This is because it is well known in the art that the time of exposing a material to the washing fluid will increase by increasing the amount of said material, and the time for exposing the material to the fluid will decrease by reducing the amount of said material. Using filter for recycling the washing solution is well known in the art (Office Action, pages 3-5).

Applicants must respectfully disagree. The Examiner is reminded that a *prima facie* case of obviousness requires: some suggestion or motivation (in either the references themselves or in the knowledge of one of ordinary skill in the art) to combine the reference teachings; a reasonable expectation of success; and a teaching or suggestion of all claim limitations.² Applicants respectfully submit the Examiner has failed to establish two of the three elements of a *prima facie* case of obviousness.

In addressing this rejection, Applicants largely focus on independent Claims 1, and 14, since "non-obviousness of an independent claim necessarily leads to non-obviousness of claims dependent therefrom." MPEP § 2143.03. Applicants respectfully point out that the claimed invention is directed to plants and methods comprising means for feeding and withdrawing "scales of plastic material in a **continuous way** to a washing apparatus" and "means for **continuously** varying the time said **scales** remain in said washing apparatus as a function of the **quantity** of scales contained in said washing apparatus." In addition, Claims 13 and 18 further require "at least one **fine pore filtering unit**" for purifying said washing fluid.

(a) No Suggestion or Motivation to Combine the References

The Examiner is also reminded that the mere fact that the references can be combined does not render the resultant modification obvious, unless the prior art also suggests the desirability of the modification.³ Buzga discloses a "*continuous* process for cleaning and preparing grossly soiled products of *plastic material...*" (See, '661, abstract, emphasis added),

² MPEP, 2143.

³ See, *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

and is categorized in US class 134 directed to cleaning and liquid contact with solids. Anderson discloses a "process of, and apparatus for, washing fragments, such as *plastic fragments*, in a *continuous* fashion as part of a recycling operation ..." (See, '041, abstract, emphasis added), and is also categorized in US class 134. In contrast, Kiuchi provides a *batch* "washing machine which is arranged to detect the dirt content of the *laundries*" (See, '447, at column 2, lines 41 and 42), and is categorized in US class 68 directed to fluid treating apparatuses for textiles. Applicants respectfully point out that although Kiuchi uses the expression continuous washing, Kiuchi apparently uses this expression to refer to *sequential washings*. Specifically, Kiuchi teaches "it may be useful during case where washing is continuously performed *subsequent* to the previous one (in the case where water drops are still adhered to the optical sensor 19 because of the previous washing" (See, '447, at column 11, lines 42-46, emphasis added).

As previously argued and as evidenced by the International Preliminary Examination Report of the priority application (submitted with the amendment and remarks filed August 28, 2003), a skilled person working with large scale continuous washing processes (such as that of Buzga and Anderson) would not find use in small scale batch washing processes (as disclosed by Kiuchi). In addition, Applicants find no basis in the Buzga and Anderson patents (directed to tools for recycling plastics) for their combination with the Kiuchi patent (directed to machines for washing clothing), or vice versa. In fact, the only motivation to combine these references is an unsupported assertion by the Examiner, which can only be based on improper hindsight knowledge of the present invention.

(b) All Claim Limitations are neither Taught nor Suggested

The Examiner is also reminded that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art."⁴ The Examiner is reminded that Claims 1 and 14 require means for feeding and withdrawing "**scales of plastic material in a continuous way** to a washing apparatus" and "varying the time said scales [of plastic material] remain in said washing apparatus as a function of the **quantity of scales** contained in said washing apparatus." As acknowledged by the Examiner, although Buzga is directed to

⁴ See, *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

continuous processes, Buzga does not teach the "means and step of continuously varying the time the scales remain in the washing apparatus as a function of the quantity of scales contained at the same moment in said apparatus" (Office Action, page 4). Moreover, although Anderson is directed to processes and machines for continuous washing, Anderson also fails to provide any means for varying the time the scales remain in the washing apparatus as a function of the quantity of scales. Similarly, although Kiuchi provides means for varying time, this means for varying time is based on a *one time detection* of the *volume of laundries* in a washer tank. Specifically, Kiuchi teaches "... a volume detecting device 20 for detecting the *volume of laundries* in the washer tank 1 using the change of a terminal voltage of the capacitor 14 *when the motor 6 is turned off*" (See, '447, at column 7, lines 23-26, emphasis added). Applicants also respectfully point out to the Examiner, that although Kiuchi may vary the time of washing based on volume of laundries, in contrast to the Examiner's assertion (and the invention as claimed) Kiuchi fails to provide any means for actually varying the volume of the laundries. In short, even if combined, the teachings of Buzga, Anderson and Kiuchi do not provide means for feeding and withdrawing **"scales of plastic material in a continuous way** to a washing apparatus" and "varying the time said scales remain in said washing apparatus as a function of the **quantity of scales**" as required by Claims 1 and 14.

The Examiner is also reminded that Claims 13 and 18 require "at least one **fine pore filtering unit**" for purifying said washing fluid. The Examiner acknowledges that Buzga and Kiuchi do not teach the filter as claimed, and that Anderson is relied upon to provide the filter means (Office Action, pages 4 and 5). However, the filter of Anderson differs from that as claimed. Specifically, instead of a fine pore filtering unit, Anderson teaches that "[w]ater and these materials are carried to a *vibrating screen separator* which removes these particles and material and recycles the water to a wash water system" (See, '041, at column 2, lines 15-18). Thus, even if combined, the teachings of Buzga, Anderson and Kiuchi do not provide the filter element as claimed.

In summary, the Examiner has not established a *prima facie* case of obviousness, because two of the three required elements were not provided. Specifically, the Examiner has failed to provide evidence of a motivation to combine the references, and even if combined, the Examiner's combination does not provide all of the claim limitations. As the claims are nonobvious, Applicants respectfully request that this rejection be withdrawn.

CONCLUSION

Applicants respectfully request that a timely Notice of Allowance be issued in this case. However, should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourages the Examiner to call the undersigned collect.

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